<u>**AMENDMENTS TO THE DRAWINGS**</u>

Two sheets of drawings is enclosed herewith. The attached drawing sheet includes amendments to Fig. 1 and Fig. 5 which should overcome objections raised by the Examiner.

Attachment: Replacement Sheet

<u>REMARKS</u>

Claims 1 – 9 and 11 – 34 are currently pending in the subject application and are presently under consideration. Claims 1, 15, 24, 29, and 32 have been amended as shown on pp. 3 – 9 of the Reply and Claim 10 has been cancelled. In addition, the specification has been amended as indicated on p. 2.

The Examiner and his supervisor are thanked for the courtesies extended during an interview conducted on January 9, 2008. The main focus of the interview was on deficiencies of the 102 and 103 rejections, objection to the drawings, and a 101 rejection. While the presented matter generally related to all the claims, the crux was upon the independent claims. In particular, references U.S. Patent No. 5,995,756 and U.S. Patent No. 6,493,868 were discussed in the interview. A set of amended claims were presented to the Examiner and the Examiner stated the 101 rejection could be overcome through adding storage or a processor to Claim 1. The interview was conducted with Ronald Krosky (Reg. No. 58,564), Examiner Thu, and Examiner Huq. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   Objection of Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84 (p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1, (hosting component$_X$) requires more labeling for clear understanding. Figure 5, (505,506 are not in the specification) and (504 is not labeled in the drawing). Replacement drawings are submitted with this response that should overcome the aforementioned objections.

II.   Rejection of Claim 1 Under 35 U.S.C. §101

Claim 1 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 1 has been amended to overcome the rejection and should now be placed into a condition of allowance.

III.   Rejection of Claims 1-14, 24, 26-34 Under 35 U.S.C. §102(b)

Claims 1-14, 24, 26-34 stand rejected under 35 U.S.C. §102(b) as being anticipated by Herrmann (US Pat No. 5,995,756). It is requested that the rejection be withdrawn in light of the

amendments. Herrmann does not disclose, teach or suggest each and every limitation of the subject claims.

> A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed invention enables an unmanaged application to function as a designer in a development environment. Claim 1 states "A system that facilitates a software development environment, comprising: a hosting component that interfaces an unmanaged application; a designer framework that interfaces a development environment, the hosting component and designer framework interface such that the unmanaged application functions as a designer within the development environment; and *a host adaptor that* merges at least one menu of the unmanaged application with at least one menu of the development environment, *determines if the development environment has focus or if unmanaged application has focus, and enables at least one merged menu item and disabled at least one merged menu item based upon a result of the determination*." (emphasis added). Claim 24, 29, and 32 recite similar limitations.

Herrmann discloses partitioning applications and integrating the application upon an Internet site. As part of Herrmann, an application development environment is used in conjunction with a visual development system (e.g., a user can create an application though engaging command areas disclosed upon a monitor). A main menu and a form are disclosed to a user, where the user populates the form with different items.

In contrast, Claim 1 recites automatically enabling and disabling different menu items. This works differently then Herrmann in various manners. Herrmann states "In typical operation, the user employs the form like a canvas, placing and arranging "components" on it to design the parts of one's user interface...Available components appear on the component palette..." (col. 6, ln 44-50). Items are placed upon a different construct (e.g., from the component palette to the form) as opposed to being enabled or disabled upon a merged construct.

Moreover, determinations on items to enable/disable and implementation of the determination is done automatically – in Herrmann, operations are performed by the user.

In view of at least the foregoing, it is readily apparent that Herrmann, neither discloses, teaches nor suggests, each and every limitation recited in independent claims 1, 24, 29, and 32 (and the claims that depend there from). Accordingly, it is respectfully submitted that Herrmann. does not anticipate the applicants' claimed invention and, therefore, it is requested that this rejection be withdrawn and Claims 1-14, 24, and 26-34 be allowed.

IV.   Rejection of Claims 15-23, 25 Under 35 U.S.C. §103(a)

Claims 15-23, 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrmann (US Pat No. 5,995,756) in view of DaSilva *et al.* (US Pat No. 6,493,868), hereafter referred to as DaSilva. Herrmann and DaSilva *et al.*, either alone or in combination, do not teach or suggest all limitations of the subject claims.

> [T]he prior art reference (or references when combined) must teach or suggest all claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 15 recites "A system that facilitates an IDE, comprising: a hosting component that interfaces to the unmanaged application such that the unmanaged application functions as a designer within the IDE, the hosting component further comprising, an integration interface to facilitate integrating a third-party unmanaged application as a designer in the development environment; a host adaptor that interfaces to the unmanaged application, the host adaptor is application specific to facilitate integrating the unmanaged application into the development environment, merges at least one menu of the unmanaged application with at least one menu of the development environment, determines if the development environment has focus or if unmanaged application has focus, and *enables at least one merged menu item and disabled at least one merged menu item based upon a result of the determination*; a document-hosting subcomponent that facilitates hosting a document that can be manipulated in the development environment, the hosted document has at least two views, including a design view

and a code view; and a designer framework that interfaces a development environment, the hosting component and designer framework interface such that the unmanaged application functions as a designer within the development environment, the hosted application operates in at least two modes including a design mode and a runtime mode to distinguish between design actions and runtime actions within the hosted application." (emphasis added).

Herrmann discloses partitioning applications and integrating the application upon an Internet site (details discussed above). DeSilva discloses an integrated development tool – specifically a tool that enables programmers to develop and analyzed embedded chip software. Source code is provided along with corresponding assembler code that is created by a build system. DeSilva also allows for a graphical interface to be used in conjunction with program development.

In contrast Herrmann and DeSilva, Claim 15 recites automatically enabling and disabling different menu items. This works differently then Herrmann in various manners. Herrmann states "In typical operation, the user employs the form like a canvas, placing and arranging "components" on it to design the parts of one's user interface…Available components appear on the component palette…" (col. 6, ln 44-50). Items are placed upon a different construct (e.g., from the component palette to the form) as opposed to being enabled or disabled upon a merged construct. Moreover, determinations on items to enable/disable and implementation of the determination is done automatically – in Herrmann, operations are performed by the user. DeSilva is completely absent discussion of menu merging, item selection, and the like. Other elements are disclosed in Claim 15 that are not disclosed in Herrmann or DaSilva, such as use of different modes and different views.

Claim 25 is dependent off Claim 24 – since the rejection against Claim 24 should be withdrawn, the rejection of Claim 25 has become moot and Claim 25 should also be placed in a condition of allowance. In view of at least the foregoing, it is readily apparent that Herrmann and DeSilva together or separate, neither disclose, teach nor suggest, each and every limitation recited in independent claim 15 (and the claims that depend there from). Accordingly, it is respectfully submitted that Herrmann with DeSivla. does not anticipate the applicants' claimed invention and, therefore, it is requested that this rejection be withdrawn and Claims 15-23, 25 be allowed.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP550US]

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

 /Himanshu S. Amin/
Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731